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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,707	02/25/2002	Ted Superak	N1305-026	5322

32905 7590 05/14/2004  
JONDLE & ASSOCIATES P.C.  
9085 EAST MINERAL CIRCLE  
SUITE 200  
CENTENNIAL, CO 80112

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/082,707	SUPERAK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anne R. Kubelik	1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-10, 34-42 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7-10 and 34-42 is/are allowed.
- 6) ☒ Claim(s) 47-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-5, 7-10, 34-42 and 47-51 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The terminal disclaimer filed on 17 February 2004 disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of copending Application No. 10/082,706 has been reviewed and is accepted. The terminal disclaimer has been recorded.
4. The objection to claim 43 because of informalities is obviated by its cancellation.
5. The rejections of claims 44-46 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over each of Miller et al (US Patent 6,031,158) and Superak (US Patent 5,959,184) is obviated by its cancellation.
6. The rejection of claims 44-46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 11-13, 15-17 and 19-33 of copending Application No. 10/082,706 is withdrawn in light of the filing of a terminal disclaimer.

### ***Claim Rejections - 35 USC § 112***

7. Claims 48-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Neither the instant specification nor the originally filed claims appear to provide support for the phrases “repeating steps (c) and (d) three or more times in succession to produce ... all of

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the physiological and morphological characteristics of same environmental conditions” in claim 48 and “wherein the plant has all of the physiological and morphological characteristics ... same environmental conditions” in claim 31. Thus, such phrases constitute NEW MATTER. In response to this rejection, Applicant is required to point to support for the phrases or to cancel the new matter.

8. Claims 48-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 14 November 2003, as applied to claims 43-46. Applicant's arguments filed 17 February 2004 have been fully considered but they are not persuasive.

Applicant urges that cancellation of claims 43-46 obviates this rejection (response pg 7).

This is not found persuasive because in the newly recited methods, it remains unclear what the identity of the plants in each of the steps would be, much less what the resultant product plant would be. Neither the plants required by each of the steps, nor the plants that are produced by the process are defined by genomic structure or by all their phenotypic characteristics, and therefore, the claimed invention lacks an adequate written description.

9. Claims 48-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 14 November 2003, as applied to claims

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43-44. Applicant's arguments filed 17 February 2004 have been fully considered but they are not persuasive.

Applicant urges that backcrossing is not unpredictable and cites Hallauer et al to urges that backcrossing is an important component of most breeding programs; backcrossing is effective for single genes. Applicant urges that the waxy and Opaque-2 genes have been used in corn breeding (response pg 7-8).

This is not found persuasive because waxy and Opaque-2 are corn genes, not squash genes. Kraft et al (2000, Theor. Appl. Genet. 101:323-326) teach that linkage disequilibrium effects and linkage drag prevent the making of plants comprising a single gene conversion, and that such effects are unpredictably genotype specific and loci-dependent in nature (pg 323, column 2, line 7 to line 15). Hallauer et al could not be considered because it was not sent.

Applicant urges that Allard states that backcrossing breeding uses a series of backcrosses to maintain the characters in which improvement is sought and that the method will result in a variety with exactly the adaptation, yield and quality as the parent (response pg 8).

This is not found persuasive. Applicant does not teach how to maintain the characters of variety of 833. Allard could not be considered because it was not sent.

10. Claims 50-51 are rejected under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If a seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same

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seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted that Applicant intends to deposit seeds for 833\*8324 at NCIMB, but there is no indication that the seeds have been deposited and there is no indication in the specification as to public availability; the previous statements refereed only to variety 833. If the deposit of these seeds is made under the terms of the Budapest Treaty, then an affidavit or declaration by the Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. A minimum deposit of 2500 seeds is considered sufficient in the ordinary case to assure availability through the period for which a deposit must be maintained.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit, meets the criteria set forth in 37 CFR 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;

(d) the viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.801 - 1.809 [MPEP 2401-2411.05] for additional explanation of these requirements.

11. Claims 1-5,7-10 and 34-42 are allowed.

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*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (571) 272-0547.

Anne R. Kubelik, Ph.D.  
May 12, 2004



**ANNE KUBELIK**  
**PATENT EXAMINER**